

REMARKS

A first non-final Office Action mailed December 23, 2003 has been received and carefully reviewed. Claims 1-32 are pending in the application. Applicant acknowledges the allowable subject matter of claims 2-4, 13-15, and 24-26 indicated by the Examiner. Claim 12 has been amended to correct a minor typographical error, and not for reasons of patentability. The amendment to claim 12 has no narrowing effect.

In paragraph 2 on page 2 of the Office Action, claims 1, 10-12, 21-23 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated *by Levine et al.* (U.S. Patent No. 6,058,328). To anticipate a claim, the asserted reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. All claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

Levine discloses a device that delivers preemptive tachyarrhythmia pacing, which can be invoked continuously or on demand. If invoked on demand, preemptive tachyarrhythmia pacing is triggered only upon the sensing of one more conditions suggesting that the onset of a tachyarrhythmia is imminent. When invoked, preemptive tachyarrhythmia pacing remains invoked only for as long as the onset-of-a-tachyarrhythmia-is-imminent condition persists (*Levine*, Abstract).

Respectfully, the preemptive tachyarrhythmia pacing feature of *Levine* fundamentally differs from the subject matter of Applicant's pending claims. *Levine*, for example, teaches enabling a tachyarrhythmia pacing therapy. Applicant's independent claims 1, 12, and 23 recite, in various forms, disabling a capability of delivering tachyarrhythmia therapy. The approach taught in *Levine* would appear to preemptively invoke, rather than disable, tachyarrhythmia pacing

under circumstances where Applicant's claims require disablement, such as during a cardiac test, such as an electrophysiologic test.

Levine also fails to teach receiving an initiation signal indicative of initiation of a cardiac test, such as an electrophysiologic test, temporarily disabling a capability of delivering disabling a capability of delivering tachyarrhythmia therapy to a chamber of the heart during the cardiac test, monitoring the heart chamber in response to the cardiac test while the capability of delivering tachyarrhythmia therapy is disabled, and automatically re-enabling the capability of delivering tachyarrhythmia therapy to ensure availability of tachyarrhythmia therapy after completion or interruption of the cardiac test.

Levine fails to teach each an every element recited in Applicant's independent claims 1, 12, and 23, and, therefore, fails to render these claims, and those that depend therefrom, anticipated.

In paragraph 4 on page 2 of the Office Action, claims 5-8, 16-19 and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Levine* in view of *Shelton* (Patent No. 5,836,989). In paragraph 1 on page 3 of the Office Action, claims 9, 20, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Levine* in view of *Bennett et al.* (Patent No. 5,213,098).

For reasons presented above, *Levine* clearly fails to teach several of Applicant's features recited in independent claims 1, 12, and 23. The teachings of *Shelton* and *Bennett* fail to supply the numerous features missing from the *Levine* teachings. Further, no motivation can be found in the references themselves to support the asserted combinations proffered by the Examiner. Clearly, the requirement of reasonable expectation of success is not met by the asserted combinations of references.

Without acquiescing to the Examiner's characterization of *Shelton* and *Bennett* as applied to Applicant's dependent claims, Applicant believes it unnecessary to address each specific ground for rejection of every dependent claim in view of the clear grounds for patentability of the claims from which they respectively depend. These dependent claims include all of the limitations of the

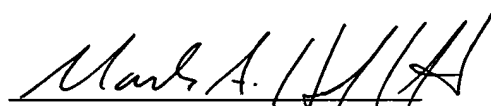
base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Applicant, however, reserves the right to address these rejections should the Examiner maintain the rejection of the base claims, notwithstanding Applicant's remarks presented hereinabove.

It is believed that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representative, at the below-listed telephone number, if there are any questions regarding the above new claims or if prosecution of this application may be assisted thereby.

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